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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,389	08/28/2003	James DeFrancesco	DLT-001DIV2	7166

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GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3692

NOTIFICATION DATE	DELIVERY MODE
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08/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PatentBos@goodwinprocter.com
hmcpeake@goodwinprocter.com
glenn.williams@goodwinprocter.com

Office Action Summary	Application No. 10/650,389	Applicant(s) DEFRANCESCO ET AL.	
	Examiner Nga B. Nguyen	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/3/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 23, 2009 has been entered.
2. Claims 1-12 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 5-8 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject

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matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 5-8 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (hereinafter Jones), U.S. Patent No. 5,239,462, in view of Bennett et al (hereinafter Bennett), U.S. Patent No. 6,603,487.

Regarding to claim 5, Jones discloses a method for receiving and routing credit application information, comprising the steps of:

receiving a credit application from at least one remote application input location (*column 5, lines 20-60, the control station receives loan application request from a borrower at a point-of-sale station*);

forwarding said received credit application to one or more funding sources (*column 7, lines 3-8, the control station forwards credit application to lender*);

receiving a funding decision from said one or more funding sources (*column 7, lines 10-17, lender sends the approve status determination to the control station*);

receiving content from said one or more funding sources (*column 7, lines 18-30, notice letter for a particular borrower includes: identify lender, approval status, maximum loan amount available for different payback times, etc...*); and

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delivering said content to said at least one remote application input location
(*column 7, lines 30-34, notice letter sends to the potential borrower at the point-of-sale station*).

Jones does not disclose selectively forwarding said received credit application to a plurality of funding sources and receiving a funding decision and content from said plurality of funding sources. However, Bennett discloses selectively forwarding said received credit application to a plurality of funding sources (*figures 7-8, the credit application is selected to forward to Chase Manhattan and Chrysler*). Although Bennett does not directly disclose receiving a funding decision and content from said plurality of funding sources, but Bennett discloses the credit application is forwarding to a plurality of funding sources, thus it is obvious in Bennett that a plurality of funding sources will send a funding decision and content back to the dealer. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Jones's to incorporate the features taught by Bennett above, for the purpose of providing the opportunity for selecting a plurality of lenders in order to ensure the loan application is approved by at least one lender.

Regarding to claim 6, Jones further discloses receiving from said one or more funding sources content targeted to select one(s) of said at least one remote application input location; and delivering said targeted content to said select one(s) of said at least one remote application input location (*column 7, lines 10-17, lender sends the approve status determination to the control station*).

Regarding to claim 7, Jones further discloses wherein content is selected from the group consisting of product information, new and used vehicle RATE PROGRAM pricing and announcement messages (*column 7, lines 18-30, notice letter for a particular borrower includes: identify lender, approval status, maximum loan amount available for different payback times, etc...*);

Regarding to claim 8, Jones does not disclose means for generating at least one defined group of said plurality of funding sources wherein said content is delivered to said at least one defined group. However, Bennett discloses generating a defined group of said plurality funding source (*figure 7, lenders receives Email, lenders receives fax*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Jones's to incorporate the features taught by Bennett above, for the purpose of ensuring the loan application is approved by sending to a group of lenders.

Claims 1-4 are written in computer readable medium that parallel the limitations found in claims 5-8 above, therefore, are rejected by the same rationale.

Claims 9-12 contain similar limitations found in claims 5-8 above, therefore, are rejected by the same rationale. Moreover, Jones discloses an apparatus comprising: a network device, a processor configured to process the method and a communications interface (*column 5, lines 20-30, the central computer located at the control location*).

Conclusion

8. Claims **1-12** are rejected.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Friday from 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

July 27, 2009